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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,695

03/22/2004

Paul V. Greco

GRECO-001

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02/08/2007

EXAMINER

LEFF, STEVEN N

ART UNIT

PAPER NUMBER

1761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/08/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/805,695	Applicant(s) GRECO ET AL.	
	Examiner Steven Leff	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 5, and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Objections*

- Claim 5 is objected to because of the following informalities: It appears that a comma may be needed between the words insoluble and odorless.  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 2, 3, 5-7, 11, 12, 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - Claim 2 is rejected due to the phrase “imparts flavor characteristics.” It is unclear as to whether the agent actually flavors the beverage or if the agent merely imparts a characteristic of a flavor to the beverage, such as scent.
  - Claims 3, 5, 12 are rejected due to the fact that the recitation of a selection from a group of elements in a claim should comply with accepted U.S. Patent practice with regard to the recitation of Markush grouping of claim elements. Phrases using “comprising” or “one of” are open sets, and should recite elements in the alternative (i.e. “comprising A, B, C or D”), whereas closed sets (“consisting of”) should recite elements as “selected from the group consisting of A, B, C and D.”
  - Claim 3 is rejected due to the word “technique(s)”. The word “technique(s)” does not provide a tangible limitation and thus does not further limit the claim. It is unclear as to whether thermal welding, etc., is actually taking place.
  - Claims 6 and 7 are rejected due to the phrase “microwave-compatible” because it is unclear as to whether the entire weight is “microwave-compatible” or a part of the weight is “microwave-compatible”.
  - Claims 6, and 7 are further rejected due to the phrase “microwave-compatible” because it is unclear as to whether the weight is compatible with microwaves in general or compatible with microwave ovens specifically.

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- Claims 6, and 7 are further rejected due to the phrase “microwave-compatible”. It is unclear as to what would make the weight “microwave-compatible”. For instance it could be based on the size being microwave oven compatible or the material does not spark when exposed to microwaves.
- With regard to claim 7, it is unclear as to what is meant to be represented by the word “material”. The word “material” does not provide a tangible limitation. For instance, it is unclear as to whether a naturally occurring rock is the weight or if the naturally occurring material is simply hard where rock is used as an adjective not a noun.
- Claim 11 is rejected due to the word “adapted”. It is unclear as to how the material has been adapted to withstand boiling water. It is unclear if the material been treated, or if the material itself is capable of withstanding boiling water.
- The term "small" in claim 17 is a relative term which renders the claim indefinite. The term "small" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what is meant by the relative word “small”.
- Regarding claim 19 the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1, 4-7, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kasket.  
(3257212)

With respect to claims 1, 4-7, and 10-11, Kasket teaches a non-floating beverage package which is to be immersed in hot water. The infusion bag comprises overlying

layer of "porous paper mats or felts which are permeable to water," (col. 2 line 5+) a "weight" (col. 2 line 35+) and an infusion beverage product, as is recited in claim 1. With respect to claims 4 and 6, Kasket recites that the infusion beverage product is located in the envelope (6) and the "weight is placed in the bottom or end of the pouch (7) or integrally attached to the bottom of the stick." (col. 2 line 35+) In addition, figure five clearly depicts that the envelope and pouch are separate compartments where the separation of the two compartments allows the liquid to flow there between. (pg. 1 col. 2 line 30+) In considering claims 5-7, Kasket continues by teaching that the "weight may be of any non-toxic, water-insoluble substance which is relatively more dense than water, such as steel, nickel, and the like," (col. 2 line 37+) where it is the Office's view that steel and nickel are naturally-occurring rock material. Regarding claim 10, Kasket teaches that the envelope is made of "porous paper mats" (pg. 2 col. 1 line 5+) where paper is made from cellulose.

With respect to claim 11, Kasket teaches that the pouch (7) is "impervious to hot water" and does not leave any taste itself to the beverage. (col. line 11+) Therefore, since the package of Kasket is intended to be used in an environment which includes hot water without degrading the package, and further since the word "hot" is a descriptive term which describes boiling water, Kasket would be expected to meet the limitations of claim 11.

Therefore Kasket anticipates claims 1, 4-7, and 10-11.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 2, 8, 9, 12, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasket. (3257212)

Kasket is taken as above.

With respect to claims 2, 12, and 18-19, although Kasket does not specifically teach that the beverage package contains tea, coffee, soups, powdered milk, etc, Kasket does teach that it was common to immerse a porous bag containing “coffee or tea (with or without powdered cream and sugar), bouillon broth, powdered cocoa preparations and the like” (col. 1 line 14+) in a cup of hot water. With respect to claims 2, 12, and 18-19, one of ordinary skill in the art would have been motivated to produce the claimed beverage product, to be immersed in water, due to the fact that the reference clearly suggests applicable alternatives for the beverage infusion product, which may be contained within the beverage package. Further one of ordinary skill in the art would have been motivated to produce flavoring aids due to the fact that the reference clearly suggests the addition of cream and/or sugar. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to produced the claimed beverage infusion products within the package due to the fact that these alternatives are clearly stated in the background of the reference.

With respect to claims 8 and 9, although Kasket does not specifically teach that the beverage package contains a dissolvable sweetener, which is additionally being used as a weight, Kasket does teach the immersion of the package within a cup of hot water and further suggests that a cream or sugar may additionally be contained in an infusion beverage package. Kasket further teaches that the package includes a separate compartment for housing a weight or weight in general. In the instance where two packages contain the same amount of infusible beverage product, where one of the packages also includes a sweetener, the sweetener is viewed as additional weight within the package thus causing the package to sink to the bottom of the immersion container at an increased rate with respect to a package without the sweetener and further causing the package to be fully immersed in the water for a longer period of time. Therefore one of

ordinary skill in the art would have been motivated to include a sweetener in the package which also functions as a weight since the sweetener is an additional component within the package, thus increasing the overall weight of the package, and in effect producing a more convenient package since constant steeping would not be required.

Further, MPEP 2144 states that "while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention." Thus according to MPEP 2144, although the applicant uses a sweetener for a different purpose, the purpose does not alter the conclusion that its use in a prior art infusion beverage package would be prima facie obvious from the purpose disclosed in the references.

Therefore, with respect to claims 2, 8, 9, 12, and 18-19, it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have included a sweetener within the package.

- Claims 3, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasket (3257212) in view of Luckhaupt. (2193974)

Kasket is taken as above.

With respect to claims 3, 10, 13, and 14, Luckhaupt teaches "an improved package for packaging and utilization of infusing material such as tea, coffee, and the like." (pg. 1 col. 1 line 2+) More specifically with regard to claim 3, Luckhaupt teaches that the beverage package is formed by "folding along line 20 in figure 3 and running a line of stitching adjacent the edges," where the same procedure is used for stitching together the other three sides of the package. (pg. 2 col. 1 line 36+) Therefore, even though Kasket does not specifically teach that the beverage infusion package is sealed on all four sides, Luckhaupt does teach that the two layers of material forming the package are joined together by stitching. Further both Kasket and Luckhaupt teach an infusion beverage package where it is desirable to contain the infusing substance within the compartments. Therefore, one of ordinary skill would have been motivated to combine the teachings of Kasket and Luckhaupt and produce an infusion beverage package where the materials are joined together and thus produce a package which will contain the infusion beverage product within the package without spilling out since all four sides are sealed.

With respect to claims 13 and 14, Luckhaupt teaches that the material utilized in stitching can be extended from the end of the package and may have a tab attached thereto. (pg. 2 col. 1 line 44+) Luckhaupt further teaches, at figure 10, that the tag may carry product indicia. Therefore, even though Kasket does not teach that the beverage infusion package comprises a string with a tag affixed thereto, Luckhaupt does teach the use of a tag with indicia which is affixed to a string where the string is attached to the package. Further both Kasket and Luckhaupt teach a means for removing the package from the infused beverage. Therefore, one of ordinary skill would have been motivated to combine the teachings of Kasket and Luckhaupt and produce an infusion beverage package, which included a string and tag in order to allow the package to be removed from the beverage container such that the use of a tool, for example a spoon, would not be required to remove the infusion beverage package prior to consumption.

Therefore, with respect to claims 3, 10, 13, and 14, it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have produced an infusion beverage package by stitching the cellulose material together thus forming a closed pouch, which also includes a string and decorated tag.

- Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasket (3257212) in view of Rambold. (3542561)

Kasket is taken as above.

With respect to claims 15-17 Rambold teaches an “infusion bag containing an infusible substance such as tea, coffee or the like for preparing a beverage.” (pg. 1 col. 1 line 21+) More specifically Rambold teaches “an infusion bag comprising at least three chambers all containing infusible substance with two outer chambers connected by a closure. At least one of the chambers has a transverse bend so as to allow the bag to be packaged in a flat condition. During use the bag is in a generally polygonal ring-like form with the lateral chambers spread apart.” (abstract)

With respect to claims 15-17, although Kasket teaches a compartmentalized infusion beverage package, which includes a first compartment that includes a weight in the bottom part thereof and a second compartment, spaced from the first, containing an infusion beverage product, Kasket is silent to the fact that a hinge separates the two compartments. Rambold does teach a bottom wall which folds for packaging. In



addition, both references teach infusion beverage packages that would allow for preparation of a beverage, and further both Kasket and Rambold teach providing a space, which would allow the liquid to flow between the compartments. Therefore, although Kasket does not teach two body portions that extend from a hinged interface, or a bottom wall which may be folded for packaging, one of ordinary skill would have been motivated to combine the teachings of Kasket and Rambold in order to produce an infusion beverage package which is capable of being more easily and compactly packed for distribution thus decreasing the overall size of the package and increasing the number of packages in a given area due to the body portions by being folded together into a relatively flat condition.

Regarding claim 16, although Kasket teaches a compartmentalized infusion beverage package which includes a first compartment that includes a weight in the bottom part thereof and a second compartment, spaced from the first, containing an infusion beverage product, Kasket is silent to the fact that the two compartments are separated by a hinge and Kasket is further silent in teaching that the overall package contains a third bottom compartment containing a weight. Rambold does teach two body portions that extend from a hinged interface and further teaches a third "bottom" compartment. In addition, both references teach infusion beverage packages, which would allow for preparation of a beverage, and further both Kasket and Rambold teach providing a space that would allow the liquid to flow between the compartments. Providing more than one chamber would cause the infusion substance to be spread out over a number of chambers and consequently over a larger surface area, thus producing a thinner layer of the substance. A thinner layer of the substance will consequently allow the infusion substance to be more effectively extracted by the infusing liquid. The weight in the bottom wall would increase the overall weight of the package thus preventing floating and causing the package to be completely submerged in the infusing liquid. Therefore, one of ordinary skill would have been motivated to combine the teachings of Kasket and Rambold in order to produce a hinged area between two separate compartments where the two compartments are further separated by a third compartment forming a bottom wall and containing a weight in order to cause the package to be more conducive to attaining the most advantageous rate of flow through the package and

through the infusing substance thus allowing the same concentration of the beverage to be attained in a shorter amount of time.

Therefore with respect to claims 15-17, it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have produced a beverage infusion package, which includes a weight and further where the package could be folded for packaging and increasing the effectiveness of the package.

### ***Allowable Subject Matter***

There is no allowable subject matter at this point

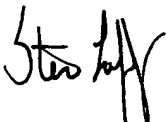
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 4609556, 3809215, 4551336, 5312318, 6851550, 5672368, 5620724, 5552164, 4826695, 3334803, 3199437, 2138358, 1976497, 3126284, 2431680, 0246192, 2137243, 1489807, 5047252, 5554400, 1428046, 4844914, 4801464, FR-2786303. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**KEITH HENDRICKS  
PRIMARY EXAMINER**